

Notice of Allowability

Application No.

09/486,129

Examiner

Callie E. Shosho

Applicant(s)

MIYABAYASHI ET AL.

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment filed 4/11/05 and telephonic interview conducted 4/20/05.
2. ☒ The allowed claim(s) is/are 1,3,4,6-9,17-21,23-25,37-41 and 45.
3. ☒ The drawings filed on 23 February 2000 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date 4/20/05
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

Callie E. Shosho
Primary Examiner
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Examiner's Amendment

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

(1) Claim 19, line 2, after "activity" and before "the", delete "and/or" and insert "and".

(2) Claim 20, line 2, after "activity" and before "the", delete "or" and insert "and".

2. Authorization for this examiner's amendment was given in a telephone interview with Julian Cohen on 4/20/05.

Statement of Reasons for Allowance

3. The present claims are allowable over the “closest” prior art Nguyen et al. (U.S. 5,990,202) for the following reasons:

Nguyen et al. disclose ink jet ink comprising water, water-soluble organic solvent, and polymer encapsulated colorant wherein the colorant is encapsulated by polymer, i.e. durable core-shell polymer, that is obtained from monomer possessing ultraviolet absorbing activity and photostabilizing activity.

(a) However, there is no disclosure that the polymer encapsulated colorant is produced by process consisting of dissolving or dispersing the dye or pigment in the monomers for constituting the polymer to form a solution or dispersion and subjecting the solution or dispersion to emulsion polymerization in water in the presence of a polymerization catalyst and emulsifier as required in present claim 1.

It is recognized that the patentability of a product does not depend on its method of production and that if the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process”, *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) and that “although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product”, *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983).

However, the product produced in Nguyen et al. is different than the product produced by the product-by-process of claim 1 given that the process of claim 1 is limited by “consisting essentially of” transitional language which limits the process to the claimed steps, i.e. subjecting

solution or dispersion of dye or pigment in the monomers for constituting the polymer to emulsion polymerization in the presence of a polymerization catalyst and an emulsifier, and those that do not materially affect the basic and novel characteristics of the process and thus, the resulting product is limited to pigment or dye encapsulated by one polymer, i.e. polymer having, in its molecular chain, sites possessing ultraviolet and photostabilizing activity.

This is in direct contrast to Nguyen et al. that always requires "dual encapsulation". That is, Nguyen et al. disclose (i) colorant encapsulated by primer core-shell polymer to form primer/colorant combination which combination is then encapsulated by durable core-shell polymer or (ii) colorant associated with primer core-shell polymer to form primer/colorant combination which combination is then encapsulated by durable core-shell polymer. It is noted that the primer core-shell polymer does not have in its molecular chain, sites possessing ultraviolet and photostabilizing activity. With respect to (i), the colorant is encapsulated by two polymers. This product is in direct contrast to claim 1 that requires product that is colorant encapsulated by one polymer. With respect to (ii), the colorant is associated with primer core-shell polymer and then the primer/colorant combination encapsulated by durable core-shell polymer. This product is in direct contrast to present claim 1 which requires product wherein the polymer encapsulates pigment or dye only. Thus, in both cases, the product of Nguyen et al. is different than the product presently claimed given that the product of Nguyen et al. always requires two polymers, i.e. primer core-shell polymer and durable core-shell polymer, while the present claims are limited to colorant encapsulated by one polymer, namely, polymer having, in its molecular chain, sites possessing ultraviolet and photostabilizing activity.

Therefore, in light of the “the consisting essentially of” transitional language in claim 1 and given that the polymer encapsulated colorant of Nguyen et al. always requires the use of two polymers and thus, falls outside the scope of the claim, Nguyen et al. is not applicable against present claim 1.

(b) With respect to present claim 45, it is noted that the claim utilizes “consisting of” transitional language with respect to the polymer encapsulated colorant. It is noted that “consisting of” limits the polymer encapsulated colorant to the claimed ingredients, i.e. pigment or dye and polymer having, in its molecular chain, sites possessing ultraviolet and photostabilizing activity.

However, as discussed in (a) above, the polymer encapsulated colorant of Nguyen et al. always requires the use of two polymers, i.e. durable core-shell polymer and primer core-shell polymer. It is significant to note that the primer core-shell polymer does not have in its molecular chain, sites possessing ultraviolet and photostabilizing activity. Thus, given that Nguyen et al. disclose the use of polymer encapsulated colorant which always requires the use of primer core-shell polymer that falls outside the scope of the “consisting of” transitional language recited with respect to the presently claimed polymer encapsulated colorant, it is clear that Nguyen et al. is not applicable against present claim 45.

Thus, it is clear that Nguyen et al. do not disclose or suggest the present invention.

In light of the above, the present claims are passed to issue.


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Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Callie E. Shosho
Primary Examiner
Art Unit 1714